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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/993,233 | 11/16/2001 | Jess E. Croya | PAY 001 | 6880 |

7590 07/09/2003

Judy Jarecki-Black, Ph.D., J.D.
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| EXAMINER |
|---|
| GONZALEZ, MADELINE |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2859 | |

DATE MAILED: 07/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/993,233 | CROYA ET AL. | |
| | Examiner | Art Unit | |
| | Madeline Gonzalez | 2859 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *01 May 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 March 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

In response to applicant's amendment dated May 1, 2003

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 3 and 4 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman (U.S. 5,894,677) in view of Quenot (U.S. 3,004,346).

Hoffman discloses a measuring device, as shown in Fig. 5, having:

- a housing 230 having a top wall 240 and a bottom wall 242 separated by a first spaced end wall 236 and a second spaced end wall 238;
- a tape outlet 244 (opening) disposed in said first spaced end wall 236;
- a tape 446, as shown in Fig. 7, having a top side and a bottom side, said tape 446 comprising an extendable length of substantially strong and durable, yet bendable material retractably disposed within said housing 230, said tape 446 including an attachment end and a terminal end;
- said tape 446 being normally, retractably stored in said housing 230 with said attachment end fixedly secured within said housing 230 and said terminal end protruding through said tape outlet 244 (opening) and being at all times exteriorly accessible of said tape outlet 244 (opening);
- said terminal end having an upper flange 450b and a lower flange 450b, as shown in Fig. 7, said upper flange extending upwardly and said lower flange extending downwardly from said tape 446 and positioned substantially perpendicular to said tape 446; and
- said top side having graduated indicia extending along substantially the entire length of said tape, as shown in Fig. 6, said indicia comprising a measuring scale; and
- wherein the top side and bottom side of said tape 446 are planar.

Hoffman lacks identical markings on the top and bottom sides of the tape, and the specific increments of the indicia.

With respect to the identical markings on the top and bottom sides of the tape: Quenot discloses a measuring instrument, as shown in Fig. 2, having a tape 1, said tape having a top side and a bottom side, said top side and said bottom side including identical scales extending along substantially the entire length of said tape 1. The scales are marked in 1/16-inch increments, as shown in Figs. 1 and 3. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add markings, as taught by Quenot, to the bottom side of the tape disclosed by Hoffman in order to be able to use the tape with either side upward, as suggested by Quenot. Furthermore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the indicia on the bottom side of the tape in order to use both sides of the tape, since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art. See *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

With respect to the specific increments of the indicia: Quenot teaches the use of a tape 1 having scales on the top and bottom sides of the tape 1, said scales are marked in 1/16-inch increments. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide a scale marked in 1/16-inch increments as taught by

Quenot in order to be able to make more accurate measurements. Furthermore, the specific increments of the indicia claimed by applicant, i.e., 1/16-inch increments, absent any criticality, is only considered to be the "optimum" increments of the scale disclosed by Hoffman as modified by Quenot that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired accuracy, manufacturing costs, etc. See In re Boesch, 205 USPQ 215 (CCPA 1980).

4. Claims 2 and 5 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman (U.S. 5,894,677) in view of Quenot (U.S. 3,004,346) as applied to claims 1, 3 and 4 above, and further in view of Knispel et al. (U.S. 5,210,956) [hereinafter Knispel].

Hoffman as modified by Quenot disclosed all the subject matter claimed above in paragraph 7 with the exception of an attachment clip, and the specific shape of the tape.

With respect to the attachment clip and the specific shape of the tape: Knispel discloses a tape measure, as shown in Fig. 2, having an attachment clip and a tape 30 having a top side and a bottom side, wherein said top and bottom sides are arcuate in cross section, as shown in Fig. 3 (see col. 3, lines 18-19). Therefore, it would have been obvious to a person having ordinary skill

in the art at the time the invention was made to provide an attachment clip as taught by Knispel, to the measuring device disclosed by Hoffman as modified by Quenot in order to be able to securely mount the device to a user's belt. Furthermore, it would have been obvious to provide a tape having a top side and bottom side being arcuate in cross section, as taught by Knispel to the device disclosed by Hoffman as modified by Quenot, since the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide using routine experimentation based on its suitability for the intended use of the invention. See In re Dailey, 149 USPQ 47 (CCPA 1976).

***Response to Arguments***

5. Applicant's arguments filed on May 1, 2003 have been fully considered but they are not persuasive.

6. In response to applicant's argument with respect to Quenot, i.e., "the first scale of Quenot has its point of origin coincident with the outer free end of the tape while the point of origin of the second scale is spaced inwardly from the free end of the tape": Quenot discloses a measuring tape having a top side and a bottom side with identical indicia extending along substantially the

entire length of the tape, as claimed by applicant in claim 1. Applicant is not claiming the point of origin of the scales. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeline Gonzalez whose telephone number is (703) 308-7004. The examiner can normally be reached on Monday-Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7724 for regular communications and (703) 305-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

MG
July 7, 2003

Diego F.F. Gutierrez
Supervisory Patent Examiner
Technology Center 2800